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THE MAXHAM FIRM
SYMPHONY TOWERS
750 "B" STREET
SUITE 3100
SAN DIEGO CA 92101

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OFFICE OF PETITIONS

In re Application of :
Bustamante, et al. :
Application No. 09/662,741 : DECISION
Filing Date: 14 September, 2000 :
Attorney Docket No.: 12755-052700US :

This is a decision on the petition filed on 21 April, 2005, under 37 C.F.R. §1.183, and considered more appropriately as a petition under 37 C.F.R. §1.47.

For the reasons set forth below, the petition:

- as considered under 37 C.F.R. §1.47 is **GRANTED**; and
- under 37 C.F.R. §1.183 is **DISMISSED**.

BACKGROUND

The record reflects that Petitioner alleges that one of the named inventors now has refused to sign the oath/declaration and seeks waiver of the statutory and regulatory requirements to proceed with the prosecution without the appropriate review of the application and signing of the oath/declaration. Specifically:

- the reissue application was filed on 14 September, 2000;
- following prosecution, the Examiner required submission of a new re-issue oath/declaration, and the instant petition was the reply thereto;
- the instant (with fee, request and fee for extension of time, correspondence and oath/declaration signed by the co-inventor Herman Bustamante (Mr. Bustamante) on behalf of himself and the co-inventor Horan Chen (Mr. Chen) but unsigned by Mr. Chen (and the assignee/assignee's authorized person) evidences that a copy of the entire application (description, claims, abstract, drawings) was transmitted to Mr. Chen at his last known address and that now response has been received from Mr. Chen to the request that he sign the oath/declaration.

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and Petitioner has shown that such action is necessary to prevent irreparable damage.

ANALYSIS

Having failed to file a properly executed oath/declaration, Petitioner contends that the Office should waive not only the Rules of Practice but statute as well (35 U.S.C. §§115 - 117) under 37 C.F.R. §1.183¹ and allow Petitioner to prosecute the instant application without satisfying the requirements of a signed oath/declaration.²

¹ The regulations at 37 C.F.R. §1.183 provide, in pertinent part:

§1.183 Suspension of the Rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. * * *

² As one registered to practice before the Office, Petitioner is familiar with the above-referenced statutes and the commentary at MPEP §409.03, et seq.:

409.03 Unavailability of Inventor

35 U.S.C. 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

Petitioner's failure to act in compliance with statute(s) and regulation(s) creates no

35 U.S.C. 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to pre-servethe rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

37 CFR 1.47. Filing when an inventor refuses to sign or cannot be reached:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the Official Gazette. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

Application papers submitted pursuant to 37 CFR 1.47 are forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions for a determination of whether the papers are proper, complete, and acceptable under 37 CFR 1.47 and for a decision on the petition under 37 CFR 1.47 before the application is sent to the Technology Center. Since an application without an oath or declaration executed by all of the inventors may be an incomplete application, an examiner should not mail an Office action in an application without a fully executed oath or declaration under 37 CFR 1.63 unless the application has been accorded status under 37 CFR 1.47 in a written decision on the petition.

A bona fide attempt must be made to comply with the provisions of 37 CFR 1.47 at the time the oath or declaration is first submitted. If the oath or declaration, and evidence submitted with the oath or declaration, are not acceptable, the 37 CFR 1.47 applicant will be notified of the reasons why the papers are not acceptable. The 37 CFR 1.47 applicant may request reconsideration and file supplemental evidence in a case where a bona fide attempt was made to comply with 37 CFR 1.47 from the outset.

A decision granting a petition under 37 CFR 1.47 does not alter the ownership interest or title of the application. If the nonsigning inventor has not signed an assignment document which has been recorded in the USPTO, then the 37 CFR 1.47 applicant (the company that files the petition under 37 CFR 1.47(b) and establishes proprietary interest in the application) is NOT the assignee of the entire interest of the application.

409.03(a) At Least One Joint Inventor Available

37 CFR 1.47(a) and 35 U.S.C. 116, second para-graph, requires all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application."

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the avail-able joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

"extraordinary situation" requiring the invocation of the interests of justice. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay.³ Moreover, the Office has no authority to waive the statutory requirements. Thus, Petitioner seeks a waiver pursuant to 37 C.F.R. §1.183⁴ that is neither justified nor permitted.

Accordingly, the petition under 37 C.F.R. §1.183 is **dismissed**.

However, as discussed above, Petitioner has evidenced his efforts in satisfaction of 37 C.F.R. §1.47(a).

Lastly, Petitioner has submitted a declaration in compliance with 37 C.F.R. §1.63 and §1.64 and Petitioner has shown that such action is necessary to prevent irreparable damage.

This application and papers have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

This application hereby is **ACCORDED status under 37 C.F.R. §1.47(a)**.

As provided under 37 C.F.R. §1.47(a), the Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition.

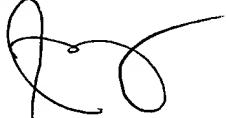
Notice of the filing of this application also will be published in the Official Gazette.

This file is released to Technology Center 2600 for further processing in due course.

³ See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the time period set forth in 37 C.F.R. 1.193(b). See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from petitioner's failure to exercise due care, or lack of knowledge of or failure to properly apply the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁴ Delay resulting from the inadvertence or mistake of Petitioner does not warrant equitable tolling of the time period of 37 C.F.R. §1.193(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983); Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Even assuming *arguendo*, that clerical inadvertence or error caused or contributed to the delay in filing the Reply Brief, such is not a ground for requesting waiver of the regulations. See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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